by the trial judge at all — there can no longer be that degree of satisfaction of guilt of an accused person which alone can justify a verdict of guilty.

There are certain other material facts too which could not be consistent with guilt. There admittedly was no animosity between the parties and the complainant himself could think of no reason why the appellant should have made the unprovoked attack on him. If there was no reason, on the one hand, for a false accusation, there was equally no reason, on the other, for the appellant to attack his inoffensive neighbour. The seriousness of the injury and the kind of weapon used should rather point to a vicious enemy and consequently, to a third party who had vanished as silently as he had appeared on the scene.

There was another error on the part of the judge in holding against the appellant certain alleged discrepancies in a police report said to have been made by the appellant of a breach of the peace in the vicinity of his house at the relevant time. The judge thought this to be merely a colourable attempt to draw a red herring across the trail. With respect, what had been overlooked was the fact that the report referred to was that of a Malay police constable, and *not* one made by the appellant, who could not be held responsible for hearsay, whether properly understood or not.

For the reasons above-stated, we allowed the appeal and quashed the conviction.

Appeal allowed.

Solicitors: *Cheang Lee & Ong.*

TIEN CHU VE-TSIN CHEMICAL INDUSTRIES (H.K.) LTD. v. MAUI-KONG VE-TSIN MANUFACTURING (MALAYSIA) CO. LTD.

[O.C.J. (Raja Azlan Shah J.) October 3, 1966]

[K.L. — Civil Suit No. 759 of 1966]

Trade Marks — Infringement and passing-off — Action for — Damages and accounts of profits — Concurrent users — Stay of action.

In an action for infringement and passing-off claims for damages and accounts of profits are alternative remedies. It is a discretion of the court to grant one of the alternative remedies on the evidence adduced at the trial.

In an action for infringement and passing-off it is a discretion of the court to grant a stay of action taking into consideration all the circumstances of the case.

Cases cited in arguments:—

(1) *U. J. James & Sons Ltd.* v. *Wafer Razor Co. Ltd.* (1932), 49 R.P.C. 597.

(2) *Flowerdale Ltd.* v. *Hale Electric Co. Ltd.* (1949), 66 R.P.C. 333, C.A.

(3) *Agfa A. G.* v. *Ilford Ltd.* [1960] R.P.C. 108.

CIVIL SUIT.

The defendants in this action applied to the Registrar of Trade Marks, States of Malaya on May 5, 1965, for registration of three marks (applications No. M/43972, No. M/43973 and No. M/44693). On May 2, 1966 the plaintiffs filed notices of opposition to the applications. On June 29, 1966 the plaintiffs issued a generally indorsed writ of summons against the defendants for infringement of their two trade marks No. M/27967 and No. M/12091 and passing-off by reasons of user of the said three marks by the defendants in relation to their products, gourmet powder. The plaintiffs claimed, *inter alia,* for damages and accounts for profits. On July 13, 1966, the plaintiffs filed and served on the defendants their statement of claim. The defendants filed their defence on July 25, 1966. The plaintiffs applied for directions for an early trial and on July 25, 1966 the court gave the directions accordingly. The plaintiffs and defendants applied for particulars of the statement of claim and defence respectively and for leave to deliver interrogatories. On September 2, 1966 the court made orders for particulars accordingly and granted leave to deliver interrogatories. On September 7 and 25, 1966 the plaintiffs and the defendants respectively gave notices to admit facts to each other. The action came up for trial on October 3, 1966.

H. Elias for the defendants: The claims for damages and accounts are alternative remedies. Plaintiffs must elect as to which of the alternatives they want.

Before the action, the defendants applied to the Registrar of Trade Marks, States of Malaya for registration of three marks. The plaintiffs filed notices of opposition to the applicants. Proceedings before the registrar are pending. The defendants are applying for stay of action in respect of the claim for infringement of trade mark No. M/12091. (*U. J. James & Sons Ltd.* v. *Wafer Razor Co. Ltd.*(1); *Flowerdale Ltd.* v. *Hale Electric Co. Ltd.*(2)).

Cheng Tim Pin for the plaintiffs: The plaintiffs cannot be required to elect as to which of the alternative remedies they want before the trial. Which of the alternative remedies they are entitled to depends on the evidence to be adduced. It is a discretion of the court to award which of the alternative remedies on the evidence adduced at the trial. (*Halsbury's laws of England,* 3rd Edn., Vol. 38, pp. 642, note (d) and 647, note (p)). The defendants cannot apply for stay of action unless the applications before the Registrar of Trade Marks are made under section 33 of the Trade Marks Ordinance, 1950. See *Halsbury's laws of England,* 3rd Edn., Vol. 38, p. 638, para. 1048. *U. J. James & Sons Ltd.* v. *Wafer Razor Co. Ltd.*(1) is to be distinguished. The decision in *U. J. James & Sons Ltd.* v. *Wafer Razor Co. Ltd.* was not followed in all subsequent cases. The applications before the registrar are not made under section 33 of the Ordinance. The facts do not justify a claim for concurrent user. The defendants' user is dishonest. An application for stay of action must be made promptly. The defendants should have made the application immediately after the service of the statement of claim. The defendants took further proceedings and allowed further proceedings to be taken.

The application is made too late and in bad faith. *Flowerdale Ltd.* v. *Hale Electric Co. Ltd.*(2); *Agfa A.G.* v. *Ilford Ltd.*(3)).

In the course of the trial judgment was entered against the defendants by consent.

Raja Azlan Shah J.: As to which of the alternative reliefs the plaintiffs will be entitled to is a discretion of the court to be granted on the evidence before the court. Whether or not there should be a stay of action is also a discretion of the court. In the circumstances of this case the court will not grant a stay and the action must proceed.

Judgment for the plaintiffs by consent.

Solicitors: *Shook Lin & Bok; Shearn, Delamore & Co.*

LEE KAR CHOO v. LEE LIAN CHOON

[P.C. (Lord Morris of Borth-y-Gest, Lord Hodson and Sir Garfield Barwick) October 4, 1966]

[Privy Council Appeal No. 26 of 1965]

Trade Marks — Passing off — Infringement — Finding that respondent's labels were calculated to enable his goods to be passed off as appellant's goods — No infringement but passing off — Whether consistent.

Passing off — Get-up of goods — Risk of confusion — Customers illiterate persons who ordered goods by reference to prominent feature on label — No infringement of appellant's trade mark, but relief granted on ground of passing off.

This was an appeal from the judgment and order of the Federal Court ([1965] 1 M.L.J. 249) setting aside a decision of the High Court. The learned trial judge had found that there had been no infringement of the appellant's trade mark and that the evidence did not support the contention of the possibility of confusion because of the respective labels in the minds of the public. He nevertheless held that the appellant had used the mark in a manner which had enabled the retailers to practise a deceit on the public and he therefore, made an order restraining the respondents from using the labels complained of. On appeal the Federal Court set aside the decision of the trial judge on the ground that as the trial judge had found that there had been no infringement of the trade mark and that the get-up of the trade mark of the respondent would not lead to confusion in the minds of the public he should have dismissed the action. The appellants appealed to the Privy Council.

Held: (1) the finding of the learned trial judge that the respective labels did not cause actual confusion and that the evidence did not support a contention that such confusion was possible was not inconsistent with his finding that, none the less particularly in the community in which the appellant's and respondent's tea was retailed, the emphasis by the respondent in his label of an essential part of the appellant's trade mark was calculated to enable a passing off to take place;

(2) the learned trial judge had come to a correct finding on the evidence and on the pleadings and therefore, the appeal must be allowed and the orders of the trial judge restored.

Cases referred to:—

(1) *Singer* v. *Loog* (1880), 18 Ch. D. 395 at p. 412.

(2) *Schweppes Ltd.* v. *Gibbens* 22 R.P.C. 113.

(3) *Saville Perfumery Ltd.* v. *June Perfect Ltd.* 58 R.P.C. 147.

(4) *Cordova & Ors.* v. *Vick Chemical Co.* 68 R.P.C. 103.

The following cases, in addition to those referred to in the judgment of the Board, were cited in argument: *Johnston* v. *Orr Ewing* (1882), 7 App. Cas. 219; *Lever* v. *Goodwin* (1887), 36 Ch. D. 1, 3 T.L.R. 650, 4 R.P.C. 492; *Reddaway* v. *Banham* [1896] A.C. 199, 12 T.L.R. 295, 13 R.P.C. 218; *Brinsmead* v. *Brinsmead* (1913), 30 R.P.C. 493; *Middlemas & Wood* v. *Moliver & Co. Ltd.* (1921), 38 R.P.C. 97; *White Hudson & Co.* v. *Asia Organization Ltd.* [1965] M.L.J. 186, [1965] R.P.C. 45; and *Eli Lilly & Co.* v. *Chelsea Drug Chemical Co. Ltd.* [1966] R.P.C. 14.

PRIVY COUNCIL.

Patrick Graham, Q.C. and *G. D. Everington* for the appellant.

P. Stuart Bevan for the respondent.

Sir Garfield Barwick: This is an appeal from a judgment and order of the Federal Court of Malaysia setting aside an order of the High Court of the Federation of Malaya granting an injunction to restrain passing off, and ancillary relief.

Lee Kar Choo, the appellant, of Market Street, Ipoh, Perak, has been trading as Yeen Thye Company for some 22 years in tea and tea dust, some of which he has sold throughout that period in packets of foil wrapped with a label which prominently displays a red coloured gold fish swimming in water contained in a scroll surrounded by flowers, upon a background of red, the whole being enclosed within a yellow frame. This device was as large as the larger side of the rectangular package and was repeated on each such side. On one end of the package, the gold fish appeared upon a background of yellow on which was written in several languages, including English, the words " 'Gold Fish' Best Quality Ceylon Tea Dust" and a telephone number, with a black and red border and a yellow surround. On the other end the gold fish appeared on a similar background with the same legend written in Chinese characters.

In 1952 the appellant registered a coloured representation of the larger section of this label as a trade mark under the provisions of the Trade Marks Ordinance of the Federation of Malaya in class 30 in respect of tea and tea dust. This registration was for a period of seven years. At the time of its registration the appellant gave an undertaking to use the mark only in colours exactly as in the specimen in the form of application for registration, *i.e.*, as earlier described. However, it has been held by the courts below and not questioned before their Lordships, that none the less the appellant was not entitled to the benefit of that part of section 22 of the Trade Marks Ordinance that required the colouring to be taken into account when considering